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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/568,345	02/14/2006	Masatoshi Kuwajima	OGW-0421	2652
23353 7590 06/23/2008 RADER FISHMAN & GRAUER PLLC LION BUILDING 1233 20TH STREET N.W., SUITE 501 WASHINGTON, DC 20036			EXAMINER FISCHER, JUSTIN R	
			ART UNIT 1791	PAPER NUMBER
			MAIL DATE 06/23/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/568,345

Applicant(s)

KUWAJIMA, MASATOSHI

Examiner

Justin R. Fischer

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2, 4, 6, 8 and 10-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2, 4, 6, 8 and 10-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 8 and 10-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Kuramori (US 6,915,824).

The applied reference has a common assignee and shared inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Kuramori teaches a runflat support member comprising a pair of elastic rings 5A,5B and an annular shell 4, wherein said shell comprises a pair of convex portions 6A,6B. The reference further teaches that the elastic rings have a different rigidity (Column 3, Lines 30-45). In this instance, the claims are directed to a runflat support member and not a wheel assembly- the runflat support member of Kuramori is capable

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of being on a rim that satisfies the claimed offset arrangement. Also, Kuramori teaches an example (Figure 1) in which the respective radii of curvature are approximately the same (Column 3, Lines 20-30).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2, 4-6, 8, and 10-12 are rejected under 35 U.S.C. 103(a) as being obvious over Kuramori.

The applied reference has a common assignee and shared inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing

that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

Kuramori teaches a runflat support member comprising a pair of elastic rings 5A,5B and an annular shell 4, wherein said shell comprises a pair of convex portions 6A,6B. The reference further teaches that the elastic rings have a different rigidity (Column 3, Lines 30-45). In particular, Figures 1 and 2 depict a structure in which elastic ring 5B is arranged on the offset side and is formed with a higher rigidity than elastic ring 5A, which is arranged on the opposite side to the offset side. The reference further depicts an annular shell having a plurality of convexly curved surface sections, wherein the respective radii of curvature are approximately the same (Column 3, Lines 20-30).

In regards to the rigidities, the reference teaches the following relationship:

$$0.1 \leq \frac{G2 - G1}{G1} \leq 2$$

Regarding claims 2 and 4, this relationship defines an offset amount L between 5 mm (lower end if ratio is 0.1) and 1,667 mm (upper range if ratio is 2). It is emphasized that the reference expressly depicts an assembly in which the rim is offset and the amount of offset would have been well within the purview of one of ordinary skill in the art absent any conclusive showing of unexpected results. In regards to Tables 1 and 2, none of the comparative examples include a runflat assembly in which the claimed relationship is not satisfied.

With respect to claims 2 and 6, the aforementioned relationship defines a ratio M between 0.8 (lower end if ratio is 0.1) and 222 (upper end if ratio is 2). As depicted in the Figures, the ratio M is at least equal to 1 (height in offset side is smaller than that in opposite side). One of ordinary skill in the art at the time of the invention would have found the claimed relationship obvious in view of this disclosure absent any conclusive showing of unexpected results.

As to claim 5, the reference clearly depicts the elastic ring on the offset side as being radially inward of the elastic ring on the opposite side- one of ordinary skill in the art at the time of the invention would have found the claimed range obvious absent any conclusive showing of unexpected results.

Lastly, with respect to claims 2, 4-6, 8, and 10-12, the wheel assembly of Kuramori appears to be the same as that of the claimed invention and thus, one would have expected the rim in the offset side to undergo greater deflection, as compared to the opposite side (amended claim language). It is emphasized that the wheel assembly of Kuramori is extremely similar to that of the claimed invention and it is unclear how the rim of Kuramori would not function in accordance to the claimed invention.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.

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1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 8 and 10-12 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,915,824.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed embodiment (instant application) is an obvious variant over that set forth in claim of US '824. It is particularly noted that the runflat support member of US '824 is capable of being mounted on a rim that satisfies the claimed offset relationship.

Response to Arguments

7. Applicant's arguments filed March 3, 2008 have been fully considered but they are not persuasive.

It is initially noted that the rejection with Glintz has been withdrawn in light of applicant's amendment.

The rejection with respect to Kuramori, however, is maintained. Applicant argues that Kuramori does not disclose or suggest a greater deflection in the offset side (as compared to the opposite side). First, it is noted that claims 8 and 10-12 are directed to a runflat member and thus any limitations directed to the rim do not further define the

claimed runflat member (represents intended use). Second, Kuramori specifically states that the elastic ring in the offset side is formed with a larger rigidity since it experiences higher loads during runflat travel. It is unclear how the rim of Kuramori does not function in the same manner as that set forth in the claimed invention.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Justin R. Fischer** whose telephone number is **(571) 272-1215**. The examiner can normally be reached on M-F (7:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Justin Fischer
/Justin R Fischer/
Primary Examiner, Art Unit 1791